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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JAN OTTO BLOM

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Appeal 2014-007181  
Application 13/099,978  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and  
CYNTHIA L. MURPHY, *Administrative Patent Judges*.  
FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE<sup>1</sup>

Jan Otto Blom (Appellant) seeks review under 35 U.S.C. § 134 of the Examiner's Final rejection of claims 1–20, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

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<sup>1</sup> Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed December 23, 2013) and Reply Brief ("Reply Br.," filed June 12, 2014), and the Examiner's Answer ("Ans.," mailed April 24, 2014), and Final Action ("Final Act.," mailed July 16, 2013).

The Appellant invented an approach for proposing social encounters among users of a social network. Specification para. 3.

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below (bracketed matter and some paragraphing added).

1. A method comprising

facilitating a processing of and/or processing, by a processor, (1) data and/or (2) information and/or (3) at least one signal,

the (1) data and/or (2) information and/or (3) at least one signal based, at least in part, on the following:

[1] location information associated with a user and other location information associated with one or more other users;

[2] social interest information associated with the user and other social interest information associated with the one or more other users;

[3] a processing of the location information, the other location information, the social interest information, the other social interest information or combination thereof

to cause, at least in part,

identification of one or more proposed encounters with respect to the user and the one or more other users;

[4] a determination of a probability that the user may attend the one or more proposed encounters;

and

[5] at least one determination to generate a presentation of the one or more proposed encounters to the user.

The Examiner relies upon the following prior art:

Whalin et al.      US 2011/0289433 A1      Nov. 24, 2011  
("Whalin")

Claims 1–10 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1–10 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

Claims 1–20 stand rejected under 35 U.S.C. § 102(e) as anticipated by Whalin.

### ISSUES

The issues of statutory subject matter turn primarily on whether the claims recite more than performing some abstract concept on a generic processor. The issues of definiteness turn primarily on whether one of ordinary skill would understand the metes and bounds of the claims. The issues of obviousness turn primarily on whether a maybe response is within the scope of some representation of probability.

## FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

### *Facts Related to the Prior Art*

#### *Whalin*

01. Whalin is directed to organizing a real-world gathering for a particular topic of interest. Whalin para. 4.
02. Whalin describes a facility for presenting users with a list of meeting events in their geographic area that are popular, such as indicated through RSVP counts. RSVP counts may be based on actual counts of ‘Yes,’ of ‘Yes’ and ‘Maybe’s,’ of a combination of these and/or other positive indicators that a member may join the meeting, and the like. Whalin para. 200.

## ANALYSIS

*Claims 1–10 rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter*

### The Supreme Court

set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First,[] determine whether the claims at issue are directed to one of those patent-ineligible concepts. [] If so, we then ask, “[w]hat else is there in the claims before us? [] To answer that question,

[ ] consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. [The Court] described step two of this analysis as a search for an [“]inventive concept[”]—i.e., an element or combination of elements that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.”

*Alice Corp., Pty. Ltd. v CLS Bank Intl*, 134 S.Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S.Ct. 1289 (2012)).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept.

While the Court in *Alice* made a direct finding as to what the claims were directed to, we find that this case’s claims themselves and the Specification provide enough information to inform one as to what they are directed to.

The preamble to claim 1 does not recite what it is for, but there are no steps recited and no result from the process is recited. The Specification at paragraph 4 recites that the invention relates to the treatments recited in claim 1 to data prior to the start of a process. Thus, all this evidence shows that claim 1 is directed to generic processing.

It follows from prior Supreme Court cases, and *Bilski* in particular, that the claims at issue here are directed to an abstract idea. Like the risk hedging in *Bilski*, the concept of generic processing is a fundamental practice long prevalent in human endeavor. Thus, generic processing, like hedging, is an “abstract idea” beyond the scope of §101. *See Alice Corp. Pty. Ltd.* 134 S.Ct. at 2356.

As in *Alice Corp. Pty. Ltd.*, we need not labor to delimit the precise contours of the “abstract ideas” category in this case. It is enough to recognize that there is no meaningful distinction in the level of abstraction between the concept of risk hedging in *Bilski* and the concept of generic processing at issue here. Both are squarely within the realm of “abstract ideas” as the Court has used that term. *See Alice Corp. Pty. Ltd.* 134 S.Ct. at 2357.

The remaining claims merely describe additional data treatments prior to the start of the claimed processes. We conclude that the claims at issue are directed to a patent-ineligible concept.

The introduction of a computer into the claims does not alter the analysis at Mayo step two.

the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea “while adding the words ‘apply it’” is not enough for patent eligibility. [] Nor is limiting the use of an abstract idea [“]to a particular technological environment.[”] Stating an abstract idea while adding the words “apply it with a computer” simply combines those two steps, with the same deficient result. Thus, if a patent’s recitation of a computer amounts to a mere instruction to “implement[t]” an abstract idea “on . . . a computer,” that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our §101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of “additional feature[e]” that provides any “practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.”

*Alice Corp. Pty. Ltd.*, 134 S.Ct. at 2358 (citations omitted).

“[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea [] on a generic computer.” *Alice Corp. Pty. Ltd.*, 134 S.Ct. at 2359. They do not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer to process data amounts to electronic data processing—one of the most basic functions of a computer. All of these computer functions are well-understood, routine, conventional activities previously known to the industry. In short, as there are no steps, the claims do no more than require a generic computer to perform generic computer functions.

Considered as an ordered combination, the computer components of Appellants’ method add nothing that is not already present when the steps are considered separately. Viewed as a whole, Appellants’ method claims simply recite the concept of generic processing as performed by a generic computer. The method claims do not, for example, purport to improve the functioning of the computer itself. Nor do they effect an improvement in any other technology or technical field. Instead, the claims at issue amount to nothing significantly more than an instruction to apply the abstract idea of generic processing using some unspecified, generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice Corp. Pty. Ltd.* 134 S.Ct. at 2360.

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*Claims 1–10 rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention*

A process claim is defined by the steps recited. Claim 1 recites no steps. Instead, these claims recite generic facilitating processing or processing, without reciting anything that occurs during such processing. Instead, the rest of the claim recites how the data used for such processing was formed prior to the start of the claimed process. Absent any recited steps, the claims leave one of ordinary skill unaware of the metes and bounds of the processes claimed.

*Claims 1–20 rejected under 35 U.S.C. § 102(e) as anticipated by Whalin*

Unlike claims 1–10, claims 11–20 are directed to apparatuses that can perform the pre-processing of the data recited in claims 1–10. The only structural limitation in these claims contested is a processor determining a probability that the user may attend the one or more proposed encounters. App. Br. 8–12. The disclosure does not lexicographically define or narrow the term “probability,” and the claims do not recite or narrow the manner of implementation for representing such a probability. In particular, the scope of the recited probability encompasses both quantitative and qualitative representations of any degree of accuracy and precision.

We are not persuaded by Appellants’ argument that

In contrast to the Examiner's arguments, ‘Maybe’ counts are not a probability, much less a determination of a probability. ‘Maybe’ means that it is unknown whether or not a member will attend an event because the member selected the response ‘Maybe’ rather than ‘Yes’ or ‘No.’ While the word, ‘maybe’ may connote some inclination towards attendance, ‘Maybe’ as

an RSVP count contains no express indication of the likelihood, possibility, much less the probability of a member's attendance for a given event. Effectively, 'Maybe' may encompass any scenario from a member attending an event to a member not attending an event. Therefore, a 'Maybe' count is actually a lack of a determination of a probability, rather than the determination of a probability alleged by the Examiner.

App. Br. 10–11. The issue is whether each of a yes and maybe response represents a probability. There can be no doubt that a yes response represents a 100% probability. We agree that a maybe response is broad and non-numeric, but again the claims do not require quantitative and precise representations. Conventionally, a maybe response is indicative of a probability greater than no and less than yes, i.e. between 0 and 100 percent. Although broad, that does cabin the range of likelihood, and is representative of such a probability.

As to the argument that Whalin's determination is not that of "the user" (App. Br. 11), in structural inventions, such claims must be distinguished from the prior art in terms of structure rather than function, *see, e.g., In re Schreiber*, 128 F.3d 1473, 1477–78 (Fed. Cir. 1997). In order to satisfy the functional limitations in an apparatus claim, however, the prior art apparatus as disclosed must be capable of performing the claimed function. *Schreiber*, 128 F.3d at 1478. When the functional language is associated with programming or some other structure required to perform the function, that programming or structure must be present in order to meet the claim limitation. *Typhoon Touch Techs., Inc. v. Dell, Inc.*, 659 F.3d 1376, 1380 (Fed. Cir. 2011) (citing *Microprocessor Enhancement Corp. v. Texas Instruments, Inc.*, 520 F.3d 1367 (Fed. Cir. 2008)). The user is not part of

the structure in the apparatus claims. The structure in Whalin is explicitly capable of determining the probability of attendance of any user.

As to the method claims, as we find in the prior rejections, these claims recite no steps, but simply perform generic processing. Whalin does at least as much. To the extent one might apply weight to the limitation regarding a determination of a probability prior to the start of the process, our finding as to the scope of the limitation of probability is equally pertinent. As to the argument regarding the probability being that of the user, we find that again accuracy is not narrowed or recited. Thus, Whalin's RSVP counts provide a rough, albeit inaccurate probability that the person relying on that count would also attend. Further, as these pre-processing limitations occur prior to the start of the process, all users who entered an RSVP answer are within the scope of the user recited in those limitations.

### CONCLUSIONS OF LAW

The rejection of claims 1–10 under 35 U.S.C. § 101 as directed to non-statutory subject matter is proper.

The rejection of claims 1–10 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention is improper.

The rejection of claims 1–20 under 35 U.S.C. § 102(e) as anticipated by Whalin is proper.

### DECISION

The rejection of claims 1–20 is affirmed.

Appeal 2014-007181  
Application 13/099,978

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2011).

AFFIRMED